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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/634,504  
Filing Date: August 05, 2003  
Appellant(s): ALVERSON ET AL.

\_\_\_\_\_  
Ernest D. Buff (Reg. #25,833)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed September 30, 2009 appealing from the Office action mailed April 27, 2009.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

### **WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 1, 2, and 4-13 raised under 35 USC, 1<sup>st</sup> paragraph.

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

5,765,138	AYCOCK et al.	6-1998
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2004/0059592	YADAV-RANJAN	3-2004
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"Business Evaluation Statements". June 23, 2003. GuruNet Software.

<<http://www.gurusoftware.com/GuruNet/Business/Topics/Evaluation.htm>>.

"Award Expiration/Closeout". University of Utah.

<<http://www.osp.utah.edu/HANDBOOK/5-7.html>>.

"Field Team Audits - Nielsen Environmental". The Nielsen Environmental Field School, Inc. 1999. <<http://envirofieldschool.com/field.htm>>.

Volpi, Ana. "Support Center Practices Certification: A Roadmap for Process Improvement Expands". January 2001. IDC

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1,2 and 4-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The second paragraph of 35 USC 112 requires a claim to particularly point out and distinctly claim the subject matter which the appellant regards as his invention. However, the “invention” referred to in the second paragraph of 35 USC 112 is also subject to the requirements of 35 USC 101. This section of the statute requires that in order to be patentable the invention must be a “new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” [emphasis added]. A claim intended to embrace or overlap *two* different statutory classes of invention set forth in 35 USC 101 is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. A single claim which purposes to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph,

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for failing to particularly point out and distinctly claim the invention. *Ex parte Lyell*, USPQ. 2d (Board of Patent Appeals and Interferences) 1548, 1551. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).

As stated above, the claimed invention is directed to a system, but recites a plurality of method/process claims. For example, claim 1 recites a plurality of "means for" surveying, mapping, on-location assessment, comparison, and reporting. However, each of the "means for" is a series of steps to be performed. Specifically, limitation (c) provides "mapping means.... said mapping means comprising examining and correlating [said] answers", and limitation (d) provides "on-location assessment means... said assessment means comprising asking questions to each of said candidates selected through said mapping means". Therefore, it is unclear what statutory class of invention the claimed invention is directed towards.

As noted above, the claimed invention recites a plurality of "means for" surveying, mapping, on-location assessment, comparison, and reporting. The cited "means for" are not modified by sufficient structure, material or acts for achieving the specified function. Further, the specification does not disclose the **structure** that enables the "means for" achieving the specified functions; therefore, it is unclear that one skilled in the art would have known what structure, material, or acts perform the

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functions recited by the "means", thereby rendering the claim indefinite because without knowing the particular structure, material or acts to perform the "means for" functions, the scope of the claimed invention cannot be determined.

Limitation (a) of claim 1 sets forth that a questionnaire is provided to selected candidates "within different organizational levels" of a contractor. However, it is unclear whether "different organizational levels" is directed towards the organizational hierarchy (i.e., worker, manager, management, CEO, etc.) or different organizational groups/divisions (i.e., accounting division, marketing division, production/manufacturing division, etc.). For examination purposes whilst employing the broadest reasonable interpretation, both possibilities are equally applicable. Clarification is required.

Limitation (c) of claim 1 sets forth that survey answers are examined to determine matches, discrepancies and inadequate details. However, it is unclear what the answers are compared to in order to determine what is a match, what is a discrepancy, and what constitutes inadequate details. For example, is checking the survey for completion (i.e., is every question answered?) the scope of "inadequate details"? In another example, are the answers mapped to a set of expected or acceptable range of responses to determine matches? Are the answers mapped to a historical set of responses to determine discrepancies? It is unclear that one skilled in the art would have known how to study the answers provided in the questionnaire to determine matches, discrepancies and inadequate details, thereby rendering the claim

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indefinite because without knowing the particular structure, standards or methodology used to perform the “mapping means”, the scope of the claimed invention cannot be determined. Clarification is required.

Further regarding claim 1, as per limitation (a), the survey questionnaire obtains information comprising management structure, reporting structure, internal communications procedures, safety and labor management practices, current projects, funding, gross margins and close out procedures, whereas the risk factors comprising the report of limitation (f) includes operational structure, marketing of new projects, current projects, details of project execution, safety procedures, statutory compliance, project administration, mediation/arbitration procedures and past litigation. It is unclear whether information for each of the risk factors of limitation (f) are collected in the survey questionnaire of limitation (a). It is unclear how the information collected from the survey maps to each of the risk factors of the report; for example, although it stands to reason that “safety and labor management practices” of the questionnaire map to the risk factor “safety procedures”, it is unclear what information from the questionnaire is directed towards “past litigation”. Clarification is required.

Claims 2 and 4-13 are dependent on claim 1 and thus are also rejected.

The means-plus-function limitations of claim 1 lack sufficient disclosure of structure under 35 USC 112, 6<sup>th</sup> paragraph, and are therefore indefinite under 35 USC



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112, 2<sup>nd</sup> paragraph. Aristocrat Technologies v. International Game Technology, 86 USPQ2d 1235 (Fed. Cir. 2008).

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, and 4-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1, as currently written, claims coverage of a human as an element of the system/apparatus per se. Since the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, the claimed invention is directed to non-statutory subject matter. See MPEP § 2105. Specifically, limitation (d) is directed towards “on-location assessment means..... said assessment means comprising asking questions to each of said candidates.... said assessment means further comprising visiting several active job sites at which said contractor is involved”. Since no structure is provided as the “means for” the assessment means, by the broadest reasonable interpretation, this is performed by a (human) user.

Claim 1, as currently written, is disclosed as a system while reciting a plurality of method/process steps. However, claim 1 lacks the requisite system structure; there is

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no combination of computer hardware and software. Therefore, the plurality of "means" is interpreted to be software per se, which is non-statutory.

A software program not embodied on computer-readable or computer-executable medium is software per se. Software, programming, instructions or code not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. Claim 1 does not utilize the proper computer program format and effectively recite descriptive material (software) per se. Claim 1 is therefore deemed to be directed to non-statutory subject matter where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

Claims 2 and 4-13 are dependent on claim 1, and thus are also rejected.

***Official Notice***

4. Although the following instances of Official Notice have already been admitted as prior art and are no longer being applied in the rejection of the claims, in an effort to make the record clear, the Examiner presents that:

In the previous Office Action mailed April 5, 2006, notice was taken by the Examiner that certain subject matter is old and well known in the art. Specifically, it has been taken as prior art that:

- The surety underwriting process involves the analysis of financial, credit, and organizational capabilities of an organization, with substantial attention paid towards reviewing the contractor's business plan, history of operations, and evaluating the management of the company, with much emphasis being placed on financial strength and past performance of the contractor.

In the previous Office Action mailed December 7, 2004, notice was taken by the Examiner that certain subject matter is old and well known in the art. Specifically, it has been taken as prior art that:

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- It is old and well known in the art that results derived from a questionnaire or auditing process are quantifiable and therefore allows a number of statistical means, including graphs, to be used in an analysis or comparison
- It is old and well known in the art that graphical representations of data can be used as a method of comparison

On page 19 of the response filed February 2, 2009, Applicant states that "[O]ne of ordinary skill in the surety art would be readily capable of utilizing a "mapping means" for examining and correlating answers as mapping means via software programs, and the like are provided in the art". Applicant further argues that "[O]ne of ordinary skill in the surety art would be able to readily apply "comparison means" for assessing business and financial practices without undue experimentation". These statements have been entered as admissions of prior art.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2 4, 5, 7, 8, 9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Aycock et al.** (Patent No. #5,765,138) in view of GuruNet's

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“Business Evaluation Statements” (previously provided, herein referred to as **GuruNet**), further in view of the Award Expiration/Closeout section of the University of Utah Research Handbook (previously provided, herein referred to as **The Utah Research Handbook**) and “Field Team Audits” by The Nielson Environmental Field School (reference 1-U, herein referred to as **Nielsen Environmental**) and **Yadav-Ranjan** (US 2004/0059592).

As per claim 1, Aycock et al. teaches a contractor certification (supplier evaluation) system for obtaining lines of credit for a building contractor comprising:

(a) survey means comprising a questionnaire (**RFP/RFQ**), stored in a computer database (**RFP/RFQ template file 102 is stored in specification database 62; specification database 62 stores the master set of supplier quality maturity requirements... the specification database serves as a library for all hardware and software specifications for known quality process standards; the user is able to interactively access databases to obtain the maturity requirements and/or specification corresponding to the displayed question from the RFP/RFQ.. the database access in step 84 accesses locally-stored databases that are included as part of the supplier-evaluation system; RFP/RFQ template file 102 includes all maturity requirements and questions necessary for the supplier to respond to the RFP/RFQ generated**), which is provided to selected candidates within a contractor’s business (**providing the RFP/RFQ to a supplier and receiving the supplier responses**) {the responses being prepared by some party within the contractor’s

**organization}** for gathering answers concerning information detailing practices, said answers being used for assessing practices of said contractor by an independent third party **(the purchasing agent identifying the set of technical requirements that need to be met may be a contracting department of the buying entity, or an independent agent acting on behalf of the buying entity)** {thus, the RFP/RFQ is based on the set of requirements of contractors identified by the independent agent in assessing the practices of vendor}, [Column 1, lines 55-56, Column 5, lines 15-16, Column 6, lines 1-9, Column 12, lines 57-62, Column 13, lines 17-20, Figures 2 and 4];

(c) mapping means for studying said answers provided to said questionnaire on said computer database **(As the supplier provides responses to the questions during the self-evaluation/verification step 82, the supplier self-evaluation system generates a supplier response file in step 86; Upon receiving the RFP/RFQ response from the supplier, the main processing system 68 stores the submitted RFP/RFQ response in the vendor database for later analysis by the user of the business terminal system 70...The user evaluating the RFP/RFQ responses then accesses the stored RFP/RFQ response from the vendor database 64 in order to analyze the supplier responses to the maturity questions, and to score the supplier responses. For example, the user evaluating the RFP/RFQ responses inputs to the business terminal system 70 a command identifying the scoring technique to be used by the main processing system 68, after which the main processing system 68 returns a calculated supplier maturity level, as well as an**

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**indication as to whether the calculated supplier maturity level is greater than the minimum maturity level)** to select job site visits and candidates for interviews **(after scoring the supplier responses, a supplier maturity level is calculated by correlating the score of each supplier response with the weighting value of the corresponding maturity question... it is then determined whether the supplier meets the minimum maturity level... if it is determined that an automatic approval of a supplier cannot be made, then an additional tier 2 analysis is performed namely performance of an on-site supplier audit to validate the supplier responses, and to gain any additional information necessary to complete the supplier selection process) {thus, job site visits are dependent on the mapping of answers with the maturity questions}** [Column 7, lines 14-65], said mapping means comprising examining and correlating said answers to determine matches, discrepancies and inadequate details **(if a supplier answers “no”, or does not provide a response, the supplier would receive a score of “0” for that particular maturity question; a response schedule may identify 10 possible items that may be identified in the supplier’s response. In this case, the supplier receives a predetermined point value for each item identified in the supplier’s response)** [Column 6, lines 63-65, Column 7, lines 7-10, Column 11, lines 10-20, Column 13, lines 5-8];

(d) on-location assessment **(on-site audit)** means for determining **(validating)** business practices at the contractor’s operations, said assessment means comprising asking questions to each of said candidates selected through said mapping means **(the**

**RFP/RFQ questions are directed towards a set of technical requirements that need to be met by prospective vendors and towards a set of selected quality maturity questions, thus the questions are based on a “mapping” of technical requirements; the questions are weighted corresponding to their relative sophistication or relevance to the project objective, thus the importance of the responses to the questions have been “mapped”) and observing examples of the contractor’s business practices (the on-site audit includes validating the supplier responses to the RFP/RFQ, either by performing actual tests on hardware equipment or software systems, and/or reviewing the quality control procedures and processes at the supplier site)** [Column 1, lines 45-49, Column 3, lines 24-29, Column 6, lines 19-54, Column 7, lines 62-65, Column 8, lines 27-31, Column 12, lines 47-50];

(e) comparison means **(risk assessment)** for assessing business practices **(technical capabilities)** by way of software evaluation of results obtained from steps a-  
d **(The user evaluating the RFP/RFQ responses then accesses the stored RFP/RFQ response from the vendor database 64 in order to analyze the supplier responses to the maturity questions, and to score the supplier responses. For example, the user evaluating the RFP/RFQ responses inputs to the business terminal system 70 a command identifying the scoring technique to be used by the main processing system 68, after which the main processing system 68 returns a calculated supplier maturity level, as well as an indication as to whether the calculated supplier maturity level is greater than the minimum maturity level)**



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and electronically ranking the contractor in comparison with industry standards **{The supplier quality maturity assessment process is based upon national and international standards including ISO 9001/ISO 9000-3, which are industry standards for quality, and the scoring is performed by the computing system, resulting in “electronic” ranking compared to industry standards}** [Column 8, lines 58-63, Column 11, lines 10-20, ]; and

(f) reporting means **(product database)** for providing a grade indicative of said contractor's rank **(competitive analysis of all vendors to determine the respective performance)** [Column 9, lines 59-67 and Column 10, lines 1-17].

Although Aycock et al. is not explicitly directed towards building contractors, contractors encompass various types of contractors (i.e., vendors, suppliers, building contractors, etc.); thus, an artisan of ordinary skill in the art would look to apply the teachings of Aycock et al. towards certifying specific types of contractors, such as building contractors.

Further regarding (a), Aycock et al. does not further explicitly disclose assessment means for determining the business and financial practices of a contractor's practices, comprising management structure, reporting structure, internal communications procedures, safety and labor management practices, current projects, funding, gross margins, and close out procedures.

However, GuruNet is directed to the analogous art of providing survey means for evaluating the business and financial practices of a company, said business practice information comprising management structure (**Questions 42, 43, 52-59, 102 of Retail, Questions 29, 30, 92 of Manufacturing, Questions 38, 39, 40, 41 of Wholesale, Questions 37-40, 107-110 of Service**), reporting structure (**Questions 44, 45, 118, 119 of Retail, Questions 36, 37 of Manufacturing**), internal communications procedures (**Questions 108, 109, 118, 119 of Retail, Questions 33, 116, 117 of Manufacturing, Questions 129, 130 of Service**), safety and labor management practices (**Questions 121, 123 of Retail, Questions 108, 119, 121 of Manufacturing, Questions 132-165 of Service**), and said financial practices of a contractor's operations comprising current projects (**Question 77 of Retail, Questions 60, 62 of Manufacturing, Questions 71, 74, 97 of Service**), funding (**Questions 76, 78 of Retail, Question 72 of Wholesale, Questions 75, 76 of Service**), gross margins (**Question 87 of Retail**).

GuruNet teaches a set of assessment statements given to staff members of a company (**Consider distributing the appropriate list of questions to your staff, have them rate each statement on a scale of 1-10, tally up and average the scores, and determine which areas need the most improvement**) [Page 1] that can be used to evaluate the financial practices (**paying bills, collecting receivables, budget analysis, accounting systems, sources of capital, cost efficiency, minimization of costs, cash flow levels**) of a company [Retail Questions 72-74, 76-89, and 127,

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Manufacturing Questions 57-68, and 123, Wholesale Questions 67-83, and 126, Service Questions 71-85, 98-100 and 138].

Aycock et al. is directed towards evaluating the capabilities of potential vendors using on-site audits and questionnaires, while GuruNet is directed towards surveying staff to evaluate the capabilities of a company. Thus, both references relied upon by the Examiner are directed towards interactively evaluating the capabilities of a business.

Aycock et al. is directed towards evaluating the business practices of potential contractors, whereas GuruNet is applied to any generic business; thus, an artisan of ordinary skill in the art would look to glean the evaluation methods of GuruNet to modify Aycock et al. to yield a more comprehensive means of evaluating the qualifications of potential contractors. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Aycock et al. to include the evaluatory statements directed towards business and financial practices presented by GuruNet, because doing so would allow Aycock et al. to evaluate the business and financial practices of a potential contractor, thereby yielding a more comprehensive means of evaluating the qualifications of potential contractors for certification.

The combined teachings of Aycock et al. and GuruNet do not explicitly teach the step of assessing a contractor's close out procedures.

However, the Utah Research Handbook teaches the use of closeout procedures **(Projects may require some or all of the following reporting: final technical, final financial, and property inventory for both purchased and government supplied equipment. A closeout may also require the submission of a final invoice and a “Contractor’s Release”)** [Paragraph 1].

Aycock et al. is directed towards evaluating the capabilities of potential vendors using on-site audits and questionnaires. GuruNet is directed towards surveying staff to evaluate the capabilities of a company. Similarly, The Utah Research Handbook outlines routine procedures expected of contractors. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the Aycock-GuruNet combination to include closeout procedures as taught by the Utah Research Handbook in the assessment step, because disclosing technical and financial information regarding specific projects in evaluating the fiscal responsibility of contractors, enhances the ability of the Aycock-GuruNet combination to assess the business and financial practices of a contractor.

As per (b) providing a questionnaire to different organizational levels comprising at least one worker, foremen, project managers, engineers, and principal:

Aycock et al. and GuruNet provide for self-assessment of the practices of a contractor, but do not explicitly disclose the job title/role or organizational hierarchical

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position (e.g., workers, foremen, project manager, engineers, and principals) of survey recipients. However, the job title and/or role of survey participants do not affect the structure or manipulative steps associated with conducting a survey and therefore do not merit patentable weight. Furthermore, workers, foremen, project manager, engineer, and principal are all employees of an organization; thus, the distribution of surveys to employees of the contractor being evaluated in the teachings of Aycock et al. and GuruNet are deemed to satisfy the limitation of the claim.

As per limitation (d), the combined teachings of Aycock et al., GuruNet, and The Utah Research Handbook fail to teach the step of on-location assessments visiting several active job sites at which a contractor is involved.

However, Nielsen Environmental teaches conducting on-location assessment visits at several job sites at which a contractor is involved **(Some clients have multiple sites, and selecting which sites at which field audits should be conducted is dependent on which will meet the objectives of the audit. For audits in which field equipment is being evaluated, we select a combination of sites which will allow us to observe all relevant equipment in use. For audits in which compliance with requirements of different regulatory agencies is being evaluated, we select a combination of sites which include all of the different regulatory jurisdictions)** [Page 2].

Aycock et al. and Nielsen Environmental are both directed towards performing on-site field audits of an organization's practices and thus are deemed to be analogous arts; therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of the Aycock-GuruNet-Utah Research Handbook. to visit multiple job sites at which a contractor is involved, because doing so would allow the Aycock–GuruNet-Utah Research Handbook combination to provide a comprehensive evaluation of a contractor's practices at a plurality of sites at which said contractor is involved, thereby enhancing the ability of Aycock et al. to validate responses to survey questions by testing and observation [Column 3, lines 36-39, Column 8, lines 27-31].

Further, one of ordinary skill in the art would have recognized that performing on-site audits at multiple locations of a contractor would yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of performing multiple on-site audits to the teachings of Aycock et al. would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to perform on-site audits and repeating on-site audits as needed. Further, applying multiple on-site audits to the teachings of Aycock et al. would have been recognized by those of ordinary skill in the art as resulting in an improved system that would verify that the contractor abides by a uniform set of standards at all places of operation, thereby strengthening the validity of contractor assessments that rely upon on-site audits.

As per (f), Aycock et al. teaches receiving and storing contractor responses to a questionnaire **(The supplier interface enables a supplier to electronically download the RFP/RFQ, which may be in the form of an executable code or a protected data file. The supplier interface may also enable the supplier to electronically upload the supplier responses to the supplier evaluation system)** [Column 3, lines 64 – Column 4, line 2] and reporting means for providing computer generated reports on the practices of a contractor **(The on-site evaluation report is compared with the supplier maturity level to provide a combined supplier evaluation between the supplier responses and the supplier site evaluation; Upon completing the on-site audit report after analyzing the audit observations in step 46, the supplier processes are scored on the basis of the on-site audit report and the selected quality maturity requirements from step 42; the user may access the supplier evaluation system 60 via the communications network 72 in order to automatically upload to the supplier evaluation system 60 an audit report)** [Column 3, lines 19-22, Column 8, lines 33-36, Column 11, lines 58-61], but does not explicitly teach a listing of key risk factors and highlights said business and financial practices and risk factors of said contractor in comparison of said risk factors, said risk factors comprising said operational structure, marketing of new projects, current projects, details of project execution, safety procedures, statutory compliance, project administration, mediation/arbitration procedures and past litigation.

However, GuruNet teaches the step of collecting information regarding operational structure (**Questions 42, 43, 52-59, 102 of Retail, Questions 29, 30, 92 of Manufacturing, Questions 38, 39, 40, 41 of Wholesale, Questions 37-40, 107-110 of Service**), marketing of new projects, current projects, details of project execution, details of project administration, safety procedures, project administration, and mediation/arbitration procedures (**including, but not limited to Questions 2, 3, 44, 45, 46, 47, 48, 51, 60, 108, 109, 112, 114, 115, 116, 119, 124, 132 and 135 of Retail relating to delegation of responsibilities and authority, the existence of standard written operating procedures, planning and implementation monitoring of activities, timely completion of operations and projects, marketing plans, cleanliness of working environments, conflict resolution, and discussion of new products, services and procedures; Questions 3, 7, 10, 15, 36, 37, 39, 108, 112, 113, 114 of Manufacturing, Questions 1-11, 13-14, 18, 25, 32 of Wholesale, etc.) {cleanliness of work areas being relevant to worker safety, conflict avoidance amongst co-workers via cooperation and teamwork being relevant to “mediation/arbitration” procedures}**).

Further, Yadav-Ranjan teaches obtaining and storing information pertaining to the business and financial practices of a contractor, including current projects, statutory compliance, mediation/arbitration procedures and past litigation of a contractor (**Data mined will include Contractor License Data, Lien Data, Business Data pertaining to a Contractor; Bank and/or Financial Institution focus on Engagement Data will**



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**be mined for Loan Amount, Engagement Beginning Date, Engagement Ending Date, Prior Relationship with Contractor Permit Number, Permit Pull County Name, Permit pull city name; County Judicial Records Department focus on Contractor Stability will be mined for Judgments against Contractor, Lawsuits against Contractor, Number of Lawsuits, and Number of Judgments) {listing current projects, current engagements, licenses, liens filed, license status and length, legal history; license status reflecting statutory compliance to license regulations for a particular state/county/jurisdiction, etc.; records of the number of lawsuits and judgments involving the contractor reflecting the adoption of an “arbitration procedure” of having decisions made in a court of law by a neutral third party} [Figure 2, Paragraphs 33-39, 74-75, 100-101, 126-127, 152-155, 159, 161, 163]**

Aycock et al. and GuruNet are directed to the analogous art of providing survey means for evaluating the practices of a company, while Yadav-Ranjan evaluates the risk associated with a contractor based on existing practices and procedures. Thus, Aycock et al., GuruNet and Yadav-Ranjan are all directed towards a similar field of endeavor, namely, evaluating the practices of a company. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Aycock et al. to include collected information regarding a contractor's operational structure, marketing of new projects, current projects, details of project execution, and project administration, as taught by GuruNet, and information regarding

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litigation history, as taught by Yadav-Ranjan, in a comparative report, because doing so would further enhance the ability of Aycock et al. to evaluate the business and financial practices of a potential contractor, thereby yielding a more comprehensive means of evaluating the qualifications of potential contractors for certification, the result of which may be used as a basis for obtaining a line of credit or loan, as intended by Yadav-Ranjan [Paragraph 179].

Further, although the combined teachings of Aycock et al., GuruNet, The Utah Research Handbook, and Nielsen environmental do not explicitly teach the step of using the assessment of a contractor's business and financial practices to secure lines of credit for said contractor's business from a surety institution, Yadav-Ranjan teaches assessing the risk associated with construction contractors to create a risk evaluation score that may be used in obtaining loans from banks and financial institutions, the risk evaluation score being based upon the business and financial practices of the contractor, as well as current and past litigation **(The Contractor can also use the calculated [Risk Assessment] score [by summing (length-of-license) plus (Cumulative-total-of-engagements) plus (number-of-Notice-of-completions) plus (Number-of-terminations) plus (Current-engagements) plus (Insurance-held divided by Total-value-of-engagement) plus (Company-structure) plus (number-of-employees) plus (years-in-trade) plus (number-of-liens) plus (Number-of-banks-used) plus (Terminations divided by Yeas-in-Business) plus (Terminations divided by Total-Engagements) plus (Delays divided by Total-Engagements) plus**

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**(Number-of-Tax-Liens) plus (Age-of-Contractor) plus (License-Type) plus (License-Status) plus (Repeat Business-with-Bank) plus (Average-size-of-Engagement) plus (Judgments) plus (Judgments-satisfied divided by Total-Number-of-Judgments) plus (Restructure of Company) plus (Number-previous-Licenses-Held) plus (Avg.-Monetary-size-proj.) plus (DB-FICO ratio)) plus Sensitivity Level or Public Trust Risk Level (SL\_PTRL) plus Security Clearance Score (SCC)] to negotiate the interest rate with Banks and Financial Institutions)**  
[Paragraphs 49, 179].

As per claim 2, although not taught by Aycock et al., GuruNet teaches a contractor certification **(company evaluation)** system with a questionnaire **(list of statements)** composed of non-threatening **(objective)** questions. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Aycock et al. to include the questionnaire featuring non-threatening questions as taught by GuruNet because doing so would enable Aycock et al. to obtain increased participation and cooperation, and further, obtaining honest opinions regarding the information necessary to conduct a proper analysis of a company's practices, thereby providing more reliable and dependent data on which to make an accurate evaluation of the company.

Furthermore, one of ordinary skill in the art would have recognized that applying the known technique of using non-threatening questions in a survey would have yielded

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predictable results and resulted in an improved system. It would have been recognized that applying the use of non-threatening questions to the surveying means of Aycock et al. and GuruNet would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to provide questions that are not intrusive or threatening while remaining effective in gathering needed information. Further, applying non-threatening questions to the surveying means of Aycock et al. and GuruNet would have been recognized by those of ordinary skill in the art as resulting in an improved system that encourages increased participation and solicits honest feedback, increasing the usefulness of data obtained from said surveys.

As per claim 4, Aycock et al. teaches a contractor certification **(supplier evaluation)** system where the on-location **(on-site)** assessments **(evaluations)** comprise job site visits **(on-site audit)** [Column 3, line 36 and Column 8, lines 20-24].

As per claim 5, Aycock et al. teaches a contractor certification **(supplier evaluation)** system where the comparison means comprises an evaluation of the contractor's business practice data against one or more databases containing performance and risk factor data from similar contractors **(existing and historical vendor performance and on-site audit reports)**, stored by the contractor certification **(supplier evaluation)** system [Column 9, lines 38-57].

As per claim 7, the teachings of Aycock et al. fail to disclose the composition of the administered questionnaire. However, GuruNet teaches a series of business evaluation statements that comprises questions directed to organizational aspects with particular reference to management structure [**Retail Questions 42,43,52-59,89**], authority delegation [**Retail Questions 44-45, Manufacturing Question 92, and Wholesale Questions 40-41**], and decision-making practices [**Retail Questions 49, Manufacturing Questions 31,and 37, Service Questions 39-40,**].

As previously noted, both Aycock et al. and GuruNet are directed towards providing surveys to evaluate the practices of an organization and are deemed to be analogous references. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Aycock et al. to include questions directed to management structure, authority delegation, and decision-making practices as taught by GuruNet to obtain an understanding of key organizational aspects that impact the daily operations of the company, making it possible to compare practices with the practices of other firms, and further yielding a more comprehensive means of evaluating the qualifications of potential contractors for certification.

As per claim 8, the teachings of Aycock et al. fail to disclose the composition of the administered questionnaire. However, GuruNet teaches a series of business evaluation statements that comprises questions directed to managerial aspects with particular reference to marketing [**Retail Questions 1-4 and 6-13, 114-117, 132,**

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**Manufacturing Questions 3,7,9-10,12, 112-114, Wholesale Questions 1-11, 13, 115-117, and Service Questions 2-8, 10-12, and 125-127], bidding processes [Question 50 of Retail directed towards purchasing system for inventory management, Question 104 of Manufacturing directed towards a supply and materials procurement system] and project execution practices [including, but not limited to Questions 44, 45, 46, 47, 48, 49, 50, 81, 105, etc.].**

As per claim 9, Aycock et al. teaches a contractor certification **(supplier evaluation)** system as recited by claim 5, where the database **(vendor database)** stored comprises a compilation of business and financial and risk data derived from contractors previously evaluated **(existing and historical vendor performance or on-site audit reports)** [Column 9, lines 38-57].

As per claim 12, neither Aycock et al., GuruNet, The Utah Research Handbook, nor Nielsen Environmental explicitly teaches a contractor certification system as recited by claim 1, wherein said reporting means is provided to lending institutions for determining an amount of credit to extend to said contractor's business.

However, Yadav-Ranjan teaches assessing the risk associated with construction contractors to create a risk evaluation score that may be used in obtaining loans from banks and financial institutions, the risk evaluation score being based upon the business and financial practices of the contractor, as well as current and past litigation

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**(The Contractor can also use the calculated [Risk Assessment] score [by summing (length-of-license) plus (Cumulative-total-of-engagements) plus (number-of-Notice-of-completions) plus (Number-of-terminations) plus (Current-engagements) plus (Insurance-held divided by Total-value-of-engagement) plus (Company-structure) plus (number-of-employees) plus (years-in-trade) plus (number-of-liens) plus (Number-of-banks-used) plus (Terminations divided by Yeas-in-Business) plus (Terminations divided by Total-Engagements) plus (Delays divided by Total-Engagements) plus (Number-of-Tax-Liens) plus (Age-of-Contractor) plus (License-Type) plus (License-Status) plus (Repeat Business-with-Bank) plus (Average-size-of-Engagement) plus (Judgments) plus (Judgments-satisfied divided by Total-Number-of-Judgments) plus (Restructure of Company) plus (Number-previous-Licenses-Held) plus (Avg.-Monetary-size-proj.) plus (DB-FICO ratio)) plus Sensitivity Level or Public Trust Risk Level (SL\_PTRL) plus Security Clearance Score (SCC)] to negotiate the interest rate with Banks and Financial Institutions) [Paragraphs 49, 179].**

Both Aycock et al. and Yadav-Ranjan are directed towards evaluating contractors based on information directed towards the practices of said contractor, and thus are analogous references. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the combined teachings of Aycock et al., GuruNet, the Utah Research Handbook, Nielsen Environmental to include the step of providing an analytical report resulting from an administered survey to lending

institutions, because the contents of such an analytical report would be a representative summary of a company's overall operations, including financial, credit, organizational capabilities, business plan, history of operations, and management of the company; thus, an analytical report resulting from the administered survey with respect to the risks and capabilities of a company may be used to obtain a line of credit or loan from a bank or financial institution, as taught by Yadav-Ranjan [Paragraph 179].

7. Claims 6, 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aycock et al., GuruNet, The Utah Research Handbook, Nielsen Environmental, and Yadav-Ranjan as applied to claim 1 above, and further in view of Ana Volpi's "Support Center Practices Certification" (reference 2-U, referred to hereinafter as Volpi).

As per claim 6, the combined teachings of Aycock et al., GuruNet, The Utah Research Handbook, and Nielsen Environmental, are silent regarding (a) sending comparison reports to the contractor and a surety institution, and (b) the use of a special logo or insignia to represent the caliber of a contractor's work or the successful completion of the certification program.

However, Volpi teaches the step of allowing certified companies to use a special logo in marketing and advertising **(Many participants found that certification raised the image of their department through the company and became a marketing tool;**



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**Renewal in the SCP program ensures that the company can continue to display the SCP certification logo for its certified support centers) [Pages 1, 7], as well as providing reports to the contractor (The audit and benchmarking reports that are provided at the end of the process are highly regarded as valuable maps, identifying areas to improve over the next year and focusing scarce resources on the areas most in need of enhancement; beyond the audit report, which details the extend to which the audited companies have met the stated criteria, participants also receive a benchmarking report. This report discusses how the company stacks up in the technology support marketplace. In contrast to the audit report, the benchmarking report highlights areas where a company may have met audit criteria but falls short compared to the technology support industry) [Pages 1, 6].**

Further, Yadav-Ranjan teaches providing the result of a certification process by a contractor to financial institutions **(The Contractor can also use the calculated [Risk Assessment] score [by summing (length-of-license) plus (Cumulative-total-of-engagements) plus (number-of-Notice-of-completions) plus (Number-of-terminations) plus (Current-engagements) plus (Insurance-held divided by Total-value-of-engagement) plus (Company-structure) plus (number-of-employees) plus (years-in-trade) plus (number-of-liens) plus (Number-of-banks-used) plus (Terminations divided by Yeas-in-Business) plus (Terminations divided by Total-Engagements) plus (Delays divided by Total-Engagements) plus (Number-of-Tax-**

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**Liens) plus (Age-of-Contractor) plus (License-Type) plus (License-Status) plus (Repeat Business-with-Bank) plus (Average-size-of-Engagement) plus (Judgments) plus (Judgments-satisfied divided by Total-Number-of-Judgments) plus (Restructure of Company) plus (Number-previous-Licenses-Held) plus (Avg.-Monetary-size-proj.) plus (DB-FICO ratio)) plus Sensitivity Level or Public Trust Risk Level (SL\_PTRL) plus Security Clearance Score (SCC)] to negotiate the interest rate with Banks and Financial Institutions) [Paragraphs 49, 179].**

Both Maldrige and the Aycock-GuruNet-Utah Research Handbook-Nielsen Environmental-Yadav-Ranjan combination are directed towards evaluating the practices of an organization, and thus are analogous references. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the combined teachings of Aycock et al., GuruNet, The Utah Research Handbook, Nielsen Environmental and Yadav-Ranjan to permit the use of a special logo or insignia in advertising and marketing representing the caliber of work performed or successful certification, because doing so would enable participants (contractors) to embark in marketing campaigns to publicly display a certification mark in conjunction with its goods and advertisements, the certification mark having discernable value in the marketplace, signifying the quality of the participant's work and the willingness to be an exemplary organization within the industry, thereby enabling participants to be recognized for the quality of work performed, making the public aware of the participant's accomplishments, abilities and strategies/practices, as taught by Volpi.

Further, one of ordinary skill in the art would have recognized that applying the technique of providing evaluation results to a financial institution would have yielded predictable results and resulted in an improved system. It would have been recognized that providing evaluation results to a financial institution would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to provide summary reports, and to share results with other parties. Further, applying the step of providing evaluation results to a financial institution to the teachings of Aycock et al. would have been recognized by those of ordinary skill in the art as resulting in an improved system that allows contractors to utilize the overall risk factor of said contractor based on a comprehensive evaluation process as a basis to obtain loans or a line of credit, as taught by Yadan-Ranjan [Paragraphs 179, 180].

As per claim 10, Aycock et al. teaches a contractor certification (**supplier evaluation**) system as recited by claim 6, where the comparison report (**vendor performance report**) sets forth said contractor's business practices (**vendor performance and on-site audit reports**) with detail sufficient to assist surety institutions engaged in underwriting a contractor's credit line [Column 9, lines 38-57].

Claim 11 recites limitations already addressed by the rejection of claim 6 above; therefore, the same rejection applies.

As per claim 13, neither Aycock et al., GuruNet, The Utah Research Handbook, Nielsen Environmental, nor Yadav-Ranjan explicitly teaches a contractor certification system as recited by claim 1 that is repeated annually.

However, Volpi teaches annual recertification of companies **(IN addition, each year the program criteria have evolved, ensuring that companies that were certified one year still need to make improvements in order to be successfully recertified the next year; Each year, companies must renew their participation in the SCP program... Renewal in the program ensures that the company maintains their status in the program)** [Pages 2, 7]

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combined teachings of Aycock et al., GuruNet, The Utah Research Handbook, Nielsen Environmental and Yadav-Ranjan to repeat the certification system on an annual basis, as taught by Volpi, in order because doing so would enable said combination to providing accurate evaluations of a company's performance that reflect up-to-date changes in evaluation standards that have been rendered obsolete over time, changes in regulations applicable to a company and/or the field of endeavor in which the company conducts business, changes in a business' performance and worth as indicated by financial and business practices, changes in management, or simply to resolve the status of a company's expiring certification, as suggested by Volpi [Page 2].

## **(10) Response to Argument**

### **35 USC 101**

1. With respect to 35 USC 101, Appellant argues on page 23 of the Appeal Brief filed September 30, 2009 that the claimed invention is tied to a particular machine and results in a transformation of subject matter, and thus, the claimed invention is in compliance with Bilski, noting that "[t]he computer, as required by Applicant's claims, provides a survey means comprising a questionnaire that is stored in a computer database, and is accessed on the contractor certification web site". Appellant argues on page 10 of the remarks filed February 2, 2009, and again on pages 20-22 of the Appeal Brief filed September 30, 2009 that "Applicant's claims provide a process eligible for protection under 35 USC 101 because Applicant's claims are tied to a particular machine or apparatus (a computer), OR, alternatively, Applicant's claims yield a process which transforms a particular article (electronic data) into a different state or thing (a grade and comparative report)".

The Examiner respectfully disagrees. The Examiner notes that the previous rejection (mailed April 27, 2009) did **not** assert that the claimed invention failed to comply with § 101 under Bilski. The Examiner further notes that Bilski is directed towards method/process claims, whereas the claimed invention is directed towards a **system**.

Firstly, the Examiner notes that there is no recitation of a contractor certification website in the specification, preamble or body of claim 1, or any other claim presented for examination; thus the reliance of a web site in this argument is moot and beyond the scope of the claimed invention as represented by the pending claims.

In order to qualify as a § 101 statutory process, based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (also referred to as the "machine-or-transformation test"). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876); *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). Also see USPTO Memoranda, "Guidance for Examining Process Claims in view of *In re Bilski*," January 7, 2009 and "New Interim Patent Subject Matter Eligibility Examination Instructions," August 24, 2009. Both memoranda may be located on the USPTO website at:

<http://www.uspto.gov/web/patents/memoranda.htm>.

Additionally, there are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patentable. This means the machine or transformation must

impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. If neither of these requirements are met by the claim, the method is not a patent eligible process under 35 U.S.C. 101 and is non-statutory subject matter.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Further, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. Incidental physical limitations, such as data gathering, field of use limitations, and extra-solution activity is not enough to convert an abstract idea into a statutory process (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed Cir. 2008)). In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. It is further noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 USC 101, as seen in the Board of Patent Appeals Informative Opinion *Ex Parte Langemyr et al.* (Appeal 2008-1495).

Contrary to the assertion made by the Appellant, the claimed invention fails the “particular machine” prong. The Examiner notes that the claimed invention does not recite a computer or any other particular machine in the preamble or within the body of the claims. Similarly, the fact that a questionnaire is stored in a computer database is not a recitation of said database; this is deemed to be a nominal recitation that does not impose meaningful limits. The structure provided for storing a questionnaire is an incidental physical limitation that does not render the claim statutory under § 101.

Furthermore, regarding the “transformation” prong, the entering of data into the database provided by the claimed invention does not represent physical and tangible objects. Rather, the claimed data represents an abstract “value”. This is different than the discussion of Abele held by Bilski, which is noted by Applicant, in which “X-ray attenuation data produced in a two dimensional field by a computed tomography scanner” was deemed to represent physical and tangible objects, because it “clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues..... the transformation of that raw data into a particular visual depiction of a physical object on a display”, resulting in a transformation of data that rendered the process patent-eligible. Further, the “transformation” of data into a visual depiction does not represent physical or tangible objects; thus, the claimed invention does not rise to the level of Abele in transforming electronically-manipulated data into patent-eligible subject matter.



2. Appellant argues that a computer is required in order to store information in a computer database, which provides the hardware components in a requisite system structure.

The Examiner respectfully disagrees. The Examiner asserts that while a computer database is cited that stores a questionnaire, said database is not explicitly recited as being a part of the claimed system.

3. Appellant argues that the claimed invention does not claim coverage of a human as an element of the system.

The Examiner respectfully disagrees. On page 21 of the response filed February 2, 2009, the Applicant has asserted that the "on-location assessment means" of limitation (d) is described in the application via specification page 20, lines 1-4. This section describes the questions presented in the survey and does not constitute how the on-location assessment is performed. In light of this fact, along with assertions made by the Applicant that further information is obtained "during interview and job site visits" [page 18 of the February 2, 2009 remarks], by using the broadest reasonable interpretation, since neither the claims nor the specification discloses the material, activity or structure responsible for this function, it is assumed that the on-location assessment is performed by a person (since neither questionnaires, computer

databases nor software are capable of performing job site visits or interviews or asking questions to interview candidates) , which is not permitted by MPEP 2105.

**35 USC 112, 2<sup>nd</sup> paragraph**

4. With respect to 35 USC 112, second paragraph, Appellant asserts that the claimed invention is not indefinite because an invention may fall within one of the four stated categories of statutory subject matter, a process, machine, manufacture, or composition of matter.

The Examiner agrees. A claim may be directed to any one of the four categories; however, as recited in the previous office action, a claim may only be directed to a single statutory class of invention (i.e., a process OR machine OR manufacture OR composition of matter). Based on the Appellant's previous remarks, it is unclear whether the claimed invention is directed towards a process since the Appellant has argued that their claimed invention is a process (see page 10 of the remarks filed February 2, 2009) or machine, as the claims are a "system" with a plurality of "means for" components..

5. With respect to 35 USC 112, second paragraph, Appellant asserts that the claimed invention is not indefinite because the specification defines the structure, material or acts for achieving the on-location assessment means, comparison means, and reporting means. Appellant further argues that the cited "means for" are modified by sufficient structure, material or acts for achieving the specified function and the

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specification discloses the structure that enables the “means for” achieving the specified functions.

The Examiner respectfully disagrees that on-location assessment means is described on page 20, lines 1-4 of the specification; this section merely discusses the survey questions. Similarly, the Examiner disagrees that comparison means is described on page 20, lines 10-12; this section discusses the survey questions pertaining to marketing and cost estimation practices. Similarly, the Examiner disagrees that reporting means is described on page 20, lines 14-17; this section discusses statutory compliance, OSHA requirements, location, size, funding, gross margins, and close out procedures for current projects. The Examiner notes that the Appellant has not provided any support in the disclosure for how the on-location assessment is performed. The Applicant has not disclosed a structure enabling the “means for” achieving the claimed functions of mapping, assessing on-location, comparing, or reporting. Although the specification specifies the content of the comparative report and the nature of the survey questions, it does not specify **who** or **what** is responsible for performing, or **how** the on-location assessment, comparison, and reporting is performed. The Examiner maintains that without knowing the specific structure, materials or acts being used, the scope cannot be determined.

**35 USC 103(a) rejection of claims 1, 2, 4, 5, 7, 8, 9, 12 and 13**

6. Appellant argues that Aycock et al. does not permit assessment of a building contractor's business by an independent third party for predicated risk rankings for securing lines of credit. Appellant argues that Aycock et al. provides for an agent acting on behalf of the buying entity to conduct an assessment.

The Examiner respectfully disagrees. The Examiner notes that the Appellant has argued limitations beyond the scope of the claimed invention; specifically, limitation (a) is directed towards "survey means comprising a questionnaire, which is provided to selected candidates within different organizational levels of a building contractor's business for gathering answers concerning information detailing business and financial practices". The fact that said survey answers are "used for assessing business and financial practices... by an independent third party" and that the financial practices are "used to predicate risk ranking when securing lines of credit for said contractor's business" are intended uses of the claimed invention.

Further, the Examiner further notes that the role of the independent third party is limited to assessing survey answers; the independent third party is not disclosed as performing the remaining steps of the certification "system", nor is the independent third party disclosed as being responsible securing lines of credit for the contractor. Any statement regarding the potential use of the "survey means" is deemed to be directed towards an intended use of the claimed invention and is not held as an actual limitation;

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thus, Aycock et al. need not teach the step of securing lines of credit to teach the claimed limitation of (a) “survey means...”.

As presented by in the previous Office Action, GuruNet is directed towards evaluating the financial status of a company, by evaluating the company’s ability to pay bills and collect receivables on time, maintaining solid cash flows, cost efficiency through minimization of waste and costs, use of detailed budgets, utilization of all possible sources of capital, accuracy in project/case/job costing/estimation methods, relationships with bankers, successful evaluation of credit risks, minimization of bad debts, etc. [see Retail Evaluation statements 72-74, 76-89, and 127, Manufacturing Evaluation statements 57-68, and 123, Wholesale Evaluation Statements 67-83 and 126, Service Evaluation Statements 71-85, 98-100 and 138]. Furthermore, the Applicant has not specified the level of evaluations deemed to be “necessary” to predicate risk ranking in securing lines of credit. The claim language merely cites that the assessment of financial practices is used, which is satisfied by the teachings of GuruNet.

The Examiner asserts that Aycock et al. does indeed permit assessment of a contractor’s business by a third party (Vendor qualification typically involves the process of a purchasing agent identifying a set of technical requirements that need to be met, compiling the technical requirements into a request for proposal or a request for quotation that is disseminated to various suppliers, receiving and evaluating the RFP/RFQ responses from the supplier.... The purchasing agent may be... an

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independent agent acting on behalf of the buying entity) [Column 1, lines 45-56],  
thereby meeting the limitation of the claim.

Lastly, the step of “obtaining lines of credit for a building contractor” merely exist in the preamble as a statement of the intended use or purpose of the claimed invention; there are no limitations within the body of the claims that actively obtain said lines of credit. Accordingly, the recitation of this step has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The Examiner further submits that whether or not answers are assessed by an “independent third party” or not, this does not affect the structure or manipulative steps associated with the claimed invention and therefore does not merit patentable weight in the recited system claim. The presence of an “independent third party” does not equate to a structural feature or difference.

7. Appellant argues that Aycock et al. and GuruNet do not provide the type of in-depth financial assessment necessary to which a surety would rely upon for surety

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lending. Appellant argues that the statements of GuruNet are vague and are only probative as subjective questions, and that certainly a surety could not possibly utilize answers to such questions to base a multi-million dollar loan upon.

The Examiner respectfully disagrees. As noted above, the Examiner notes that the Appellant has argued limitations beyond the scope of the claimed invention; specifically, limitation (a) is directed towards “survey means comprising a questionnaire, which is provided to selected candidates within different organizational levels of a building contractor’s business for gathering answers concerning information detailing business and financial practices” and not towards performing a financial assessment necessary for surety lending. The fact that said survey answers regarding financial practices are “used to predicate risk ranking when securing lines of credit for said contractor’s business” is an intended use of the claimed invention. Using answers to predicate risk ranking is indicative of comparison or assessment of the contractor, and not a part of the survey administration.

The Examiner notes that limitation (d) only performs on-location assessment for observing/verifying the answers to the survey, and limitation (e) assesses business and financial practices, but that the claimed invention does not explicitly cite the step of performing the financial assessment necessary for surety lending. Although the contractor certification resulting from the claimed invention may be used in this way (i.e., for obtaining a line of credit), this limitation is not required to teach the claimed

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invention. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., providing the financial assessment necessary for surety lending) are not recited in the rejected claim(s), and merely exist in the preamble as a stated intended use.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Similarly, as noted above, the step of "obtaining lines of credit for a building contractor" merely exist in the preamble as a statement of the intended use or purpose of the claimed invention; there are no limitations within the body of the claims that actively obtain said lines of credit. Accordingly, the recitation of this step has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The Examiner further notes that the amount of the loan is not recited in the claims, and thus, this argument is beyond the scope of the claimed invention.

Furthermore, the Applicant has made a mere allegation that the GuruNet statements



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are inadequate to base any lending decision on. The claimed invention merely recites that answers to the survey questions are used to assess the business and financial practices of a contractor, which is indeed performed by the teachings of Aycock et al. and GuruNet. The claimed invention does not specify any specific questions and merely lists categories to be addressed by the survey (management structure, reporting structure, internal communications procedures, safety and labor management practices, current projects, funding, gross margins, and close out procedures), which are taught by GuruNet, and the Utah Research Handbook.

8. Appellant argues that the combination of Aycock et al., GuruNet, Utah Research Handbook, Nielsen Environmental and Yadav-Ranjan do not teach assessment means for determining the business and financial practices of a contractor's practices, comprising management structure, reported structure, internal communications procedures, safety and labor management practices, current projects, funding, gross margins and close out procedures.

The Examiner respectfully disagrees. As cited in the previous Office Action, GuruNet is deemed to assess certain business and financial practices of the contractor, specifically, management structure, reporting structure, internal communication procedures, safety and labor management practices, current projects, funding, and gross margins, and The Utah Research Handbook discloses close out procedures. Further, as cited in the previous Office Action, and above, the Examiner asserts that an

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artisan of ordinary skill in the art would have looked to apply the teachings of Aycock et al. towards the certification of any type of contractor, including building contractors.

Further, the Examiner notes that the evaluation of contractors consists of obtaining information about the business and financial practices, elements that are applicable to contractors in any field of endeavor, whether it is building construction, logistics, manufacturing, etc.

9. Appellant argues that the statements provided by GuruNet do not provide the type of in-depth information to which a surety would rely upon in extending credit. The Appellant further argues that these statements are only probative as subjective questions and are vague, as they merely assist a business owner in finding weakness and could not possibly utilize answers to such questions to base a multi-million dollar loan upon, and that any combination of Aycock et al. and GuruNet would not yield a system that provides an accurate, concise, in-depth assessment of a building contractor's business which a surety would rely upon. The Applicant further asserts that GuruNet would only provide a biased rating anywhere from 1-10.

The Examiner respectfully disagrees. In response to Appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., providing accurate, concise, in-depth assessment) are not recited in the rejected claim(s). Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner notes that the Appellant's argument extends beyond the scope of the claimed invention; specifically, the survey means of limitation (a) simply cites a questionnaire used to gather information detailing the business and financial practices of the contractor. There is no mention regarding how detailed or specific the questionnaire is, other than a limitation in claim 2 that the questions are non-threatening, which itself is "vague". The Examiner further notes that using the responses to the questions to base a multi-million dollar loan is an intended use or application of the claimed invention, and further that it is the certification of the contractor (that results from the claimed invention) and not the survey answers themselves that are used to secure loans from a surety institution. The Examiner notes that the vagueness of the GuruNet statement, as argued by the Appellant, do not preclude GuruNet from meeting limitation (a) of the claimed invention because it is indeed directed towards a questionnaire gathering information detailing the business and financial practices of the contractor. Thus, the Examiner asserts that GuruNet does indeed satisfy the limitation of the claimed invention.

10. Appellant argues that the Examiner's reliance on The Utah Research Handbook for teaching the step of assessing a contractor's close out procedures is misplaced because it does not involve a building contractor or builder but merely involves

government contract awards and the University's handling of closeout procedures, which is not indicative of closeout procedures for building contractors.

The Examiner respectfully disagrees. The Utah Research Handbook outlines the closeout procedures required of contractors involved in a project. As noted above and in the previous Office Action, a contractor is one that agrees to furnish materials or perform services at a specified price, and the term "contractor" encompasses various types of contractors, such as vendors, suppliers, building contractors, etc. Further, the Examiner notes that the closeout procedures are directed towards projects, which implies that the participation of the contractor is in a service (i.e., building, construction, etc.) providing capacity. Thus, the Examiner asserts that the reliance on The Utah Research handbook is not misplaced, and does indeed teach closeout procedures for contractors.

11. Appellant argues that the combination of Aycock et al., GuruNet, Utah Research Handbook, Nielsen Environmental and Yadav-Ranjan do not permit providing the survey to selected candidates within a building contractor's business comprising workers, foremen, project managers, engineers, and principals. Specifically, Appellant argues that Aycock et al. provides surveys to different companies, and that GuruNet does not teach that the assessment statement be given to workers, foremen, project managers, engineers, and principals.

The Examiner respectfully disagrees. As noted by the Appellant, GuruNet sets forth that the statements be given to staff members of the company being evaluated. GuruNet teaches to distribute the appropriate list of questions to the staff of a company, which would include various levels of employees. The Examiner asserts that the staff of a company would comprise workers from a plurality of organizational levels (i.e., workers, supervisors, management, mid-management, upper-management, etc.); thus workers and management alike would be given the list of questions for evaluation. The Examiner asserts that "staff members" of an organization encompasses workers, foremen, project managers, engineers and principals, and thus satisfies the limitation of the claim. Further, in Aycock et al., in order to submit a RFP/RFQ, appropriate information must be obtained from those who are knowledgeable with the operations of the contractor's business. Although Aycock et al. does not explicitly disclose the job title/role or organizational hierarchical position (workers, foremen, project manager, engineers, and principals) of survey recipients, the Examiner asserts that the survey would be distributed to different levels and departments encompassing an organization.

Further, the Examiner notes that the job title/role of the questionnaire participant does not affect the structure or manipulative steps associated with conducting a survey. The job title or role does not equate to a structural feature or difference.

12. Appellant argues that the job title and role of participants vastly affects the structure and steps associated with conducting a survey vastly affects the function in

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the survey in that it uniquely provides a multifaceted survey approach that goes to the very core and intricacies of a business. The Appellant argues that requiring the survey to be given to such a wide demographic of the organization is a functional recitation that must be given patentable weight because it results in causing the questionnaire to function as a multifaceted assessment process.

The Examiner respectfully disagrees. The Examiner asserts that the identify or job title/role (i.e., worker, manager, engineer, etc.) of the participants does not impact the structure of the survey nor the manipulative steps associated with scoring the survey as claimed. For example, the survey is not customized based on the recipient (i.e., a worker receives a different survey than a manager or engineer), nor are the survey results of one type of recipient weighted differently (i.e., more heavily) than the survey results of another type of recipient (i.e., the responses of a worker are given twice as much weight as the responses of a manager, etc.). As the surveys are neither customized based on the recipient nor evaluated differently based on the recipient, the stated goal of obtaining a representative and multifaceted assessment is achieved by providing the questionnaire to workers arbitrarily, as taught by GuruNet. The Examiner notes that the claimed invention provides surveys "to selected candidates within different organizational levels", but does not preclude "different organizational levels" from being directed towards different hierarchical levels or different divisions/areas of the contractor. The Examiner further notes that GuruNet provides a plurality of question to assess performance/practices with respect to retail, manufacturing, wholesale, and

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service, implicitly suggesting that the company being evaluated has at least the aforementioned “levels” or divisions, thereby teaching the limitation of the claim.

13. Appellant argues that the teachings of Aycock et al., GuruNet, Utah Research Handbook, Nielsen Environmental and Yadav-Ranjan fail to teach a system that automatically incorporates on-location assessments. The Appellant argues that Aycock et al. only provides for on-location assessment based on contingencies and are not automatically appointed for carrying out. The Appellant argues that the on-location assessment means is not performed to verify and otherwise confirm the answers when the supplier’s answers are incorrect, exaggerated, or otherwise misguided and the supplier is approved.

The Examiner respectfully disagrees. Although Aycock et al. only provides for on-location assessment on an as-needed basis, this does not preclude the fact that Aycock et al. does indeed teach the step of performing an on-location/onsite project site audit. Aycock et al. teaches that the on-site audit includes validating the supplier responses to the RFP/RFQ by performing tests and reviewing procedures and processes at the site [Column 8, lines 27-31].

In Aycock et al., the scoring of responses to the questionnaire is based on a predetermined “answer key” (a response schedule may identify 10 possible items that may be identified in the supplier’s response. In this case, the supplier receives a

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predetermined point value for each item identified in the supplier's response) [Column 7, lines 7-10] and the adequacy of the response (if a supplier answers "no", or does not provide a response, the supplier would receive a score of "0" for that particular maturity question) [Column 6, lines 63-65]. The Examiner asserts that the supplier responses are compared by awarding points for correlating matches with the response schedule, discrepancies are not awarded any points, inadequate answers are given a score of "0" or not awarded any points, and based on the maturity score, a decision is made regarding the necessity of an on-location assessment; thus, the on-location assessment of Aycock et al., is indeed utilized upon compiling questionnaire answers and correlating matches, discrepancies and inadequate information.

Further, the Examiner notes that whether or not on-location assessments are performed does not affect the structure or manipulative steps associated with performing on-location assessment of business and financial practices and procedures at job sites. The "on-location" limitation does not equate to a structural feature or difference.

14. Appellant argues that any information collected by the statements taught by GuruNet would not be substantial enough or function to render information for which a surety can rely upon. The Appellant asserts that the questions merely provide blanket statements and do not render detailed answers. Appellant argues that GuruNet does not teach listing of key risk factors comprising operational structure, marketing of new



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projects, current projects, details of project execution, safety procedures, statutory compliance, project administration, mediation/arbitration procedures and past litigation. Appellant further argues that GuruNet will not provide the lender with dynamic information (financial or operational) that reduces or affects the risk or its analysis parameters.

The Examiner respectfully disagrees. In response to Appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., obtaining detailed answers to the survey on which a surety can rely upon) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As explained above, the claimed invention does not specify how in-depth the questions are, nor the required depth of the answers. The Examiner again notes that a surety institution utilizes the contactor certification (that results from application of the claimed invention); in other words, the overall assessment is used, not solely the response to the survey questions. Further, the Examiner asserts that simply listing the topics of the survey questions (i.e., operational structure, marketing of projects, etc.) does not inherently provide detailed answers. For example, a question such as "Does your company have an established set of safety procedures" does not render detailed

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answers, yet meets the limitation of the claim. Similarly, the questions "What are the safety procedures employed by your organization" or "Does your organization utilize the safety procedures set forth by Directive Alpha Beta" or "Are the safety procedures of your organization in compliance with OSHA rules and regulations regarding chemical waste" may also render more detailed answers while meeting the limitation of the claim.

Lastly, the Examiner notes that, as per limitation (a), the survey questionnaire obtains information comprising management structure, reporting structure, internal communications procedures, safety and labor management practices, current projects, funding, gross margins and close out procedures, whereas the risk factors comprising the report of limitation (f) includes operational structure, marketing of new projects, current projects, details of project execution, safety procedures, statutory compliance, project administration, mediation/arbitration procedures and past litigation. It is unclear whether information for each of the risk factors of limitation (f) are collected in the survey questionnaire of limitation (a). It is unclear how the information collected from the survey maps to each of the risk factors of the report; for example, although it stands to reason that "safety and labor management practices" of the questionnaire map to the risk factor "safety procedures", it is unclear what information from the questionnaire is directed towards "past litigation".

**35 USC 103(a) rejection of claims 1, 6, 8, and 11 as pertaining to Official Notice**

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15. Appellant argues on page 66 of the Appeal Brief that regarding claim 8, the Examiner has stated that Official Notice is taken that questions regarding a company's bidding process and project execution practice are vital components in defining a company's management practices and an evaluation of these practices would be needed to formulate a comprehensive assessment that can be used to compare the company with other companies is respectfully traversed. Appellant notes that the Official Notice was challenged in the response filed March 15, 2005 in response to the Office Action dated June 15, 2005, which was the Examiner's first notice of the particular Official Notice.

The Examiner respectfully submits that all arguments directed towards Official Notice as applied to claim 8 are moot, as Official Notice is not currently being applied to the claim in question.

16. Similarly, Appellant argues on page 69 of the Appeal Brief that sole reliance on Official Notice has resulted in the rejection of the preferred embodiments of both claims 6 and claim 11.

The Examiner respectfully submits that all arguments directed towards Official Notice as applied to claims 6 and 11 are moot, as Official Notice is not currently being applied to the claim in question.

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17. Appellant argues on page 59 of the Appeal Brief that any acknowledgement Examiner has taken as Official Notice that evaluations of a business can be used for a plurality of applications, such as establishing insurance premiums or loans of credit, and that the surety underwriting process involves the analysis of financial, credit, and organizational capabilities of an organization, does not change the fact that any combination of the method of Aycock et al. with the statements of GuruNet would not yield a system that provides an accurate, concise, in-depth assessment of a building contractor's business on which a surety would rely upon. Appellant further argues that the Official Notice does not establish evaluations of a business as applied by claim 1, in the context of a building contractor's business.

The Examiner respectfully submits that all arguments directed towards Official Notice as applied to claim 1 is moot, as Official Notice is not currently being applied to the claim in question.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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/P. C./

Examiner, Art Unit 3623

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623

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